

### **Remarks/Arguments**

The Examiner has rejected Claims 1-13, 15, 16, and 20 based on written description requirements; Claims 2, 5, 6, 8-13, 15, 16, and 19 stand rejected under indefiniteness; Claims 1-3 and 5-20 are rejected under obviousness considerations of *Verhaeghe* (US 2002/0170398 A1) in view of the combination of *Sanders et al.* (US 6213302 B1) and *Bettencourt et al.* (US 3986561.)

Claims 1-3 and 5-20 remain in the application; Claims 1, 2, 5, 5, 6, 10, 15, 19 and 20 have been amended; Claims 3, 7, 12, 13, 16, 17 and 20 remain as originally presented. Claim 4 was previously cancelled.

#### **35 USC § 112 paragraph 1 – “Common Facility”**

Applicant has amended Claims 1, 8, and 20 to change the limitation from “common” facility to “shelf stable processing” facility. Antecedent basis for this amendment is found in the specification at **p 4, lines 22-24, p 6 lines 26 – 27.** Applicant’s amendment should not be construed as an admission or agreement with the Examiner’s rejection. The word “common” was intended to mean combined and is a synonym for “*consolidated*,” “*shared*” or “*combined*” which Applicant believes is clearly supported by the specification at least at **p 4, lines 22-24,** which describes one aspect of the invention as

*“consolidate[ing] fresh cut produce processing and shelf stable processing of produce in a way which utilizes **existing harvesting and shelf stable processing systems**.”*

#### **35 USC § 112 paragraph 1 – “Cutting” vs. “Diverting”**

Applicant has amended the preamble of Claims 2 and 15 to reflect the originally submitted preamble, i.e., the term “*cutting*,” has been changed back to the original term “*diverting*,” which the Examiner noted is fully supported by the written description. Applicant’s amendment should not be construed as an admission or agreement with the Examiner’s rejection. For the reasons set forth above, Applicant respectfully requests reconsideration and withdrawal of all rejections under 35 USC § 112 paragraph 1.

**35 USC § 112 paragraph 2 – “Undesirable Sections”**

Applicant again respectfully traverses Examiner’s rejection of the term “*undesirable sections*,” as indefinite of Claims 2, 6, 8, 11, 15, and 16. Applicant strongly disagrees with Examiner’s determination that verbatim reproduction of terms specifically defined and appearing in the specification constituting “*undesirable sections*,” is indefinite. Applicant is allowed to be his own lexicographer, even though there is no intended change in the dictionary definition of what constitutes “*undesirable*,” i.e., “*unwanted*.” Moreover, Examiner’s own cited art to Cruess; p 430, paragraph 2 “*color/ripeness*,” p 432, paragraph 2 “*mold, unripe, overripe, dirty*,” p 432 paragraph 3, “*insects*,” p 433 paragraph 5 “*sanitary*,” p 434 paragraph 2 “*decayed*,” and paragraph 0019 of Verhaeghe states

*“As already explained above, left and right hand end slices (tops and bottoms) of vegetables and, more in particular of tomatoes, are not desired by the consumer as they possess less tasty components such as style pieces, stalk pieces, the sepal, calyx pieces, peduncle pieces, and root pieces. The invention solves these inconveniences by offering a device that enables the collection of the desired slices only, being the intermediate slices.”*

clearly supports the contention that one having ordinary skill in the art would know what constitutes “*undesirable*.”

Additionally, Applicant points out the examination standards pursuant to MPEP § 2106C;

*“USPTO personnel must always remember to use the perspective of one of ordinary skill in the art. Claims and disclosures are not to be evaluated in a vacuum. If elements of an invention are well known in the art, the applicant does not have to provide a disclosure that describes those elements.”*

The level of skill required to determine what is “*undesirable*” is well known in the art and is furthermore a matter of common knowledge and sense. The diverted fresh produce is clearly intended for human consumption as is expressly stated in the specification;

*“Demand for fresh cut produce such as fresh cut fruits and vegetables is increasing significantly as **consumers** become more health conscious and the nutritional benefits of **consuming fresh fruits and vegetables** becomes more well known and understood.” (p 1, lines 1 – 5.)*

Purchasing fresh produce from a supermarket is so well known and understood that consumers visually observing

*“bruised portions, damaged portions, decayed portions, insect infested portions, non-uniform colorations, etc.” (p. 7, lines 7-9,)*

on fresh produce would avoid purchasing the so affected product. This is routinely practiced by the general population and is not limited only to those *“persons having ordinary skill in the art.”* In terms of the Examiner’s comment regarding purportedly unbounded *“examples,”* Applicant directs Examiner’s attention to MPEP at § 2164.02 which states;

*“An example may be “working” or “prophetic.” A working example is based on work actually performed. A prophetic example describes an embodiment of the invention based on predicted results rather than work actually conducted or results actually achieved.”*

While this section of the MPEP is directed toward enablement, the basic requirements are applicable to 35 USC § 112, second paragraph as well. The specification need only provide sufficient detail to facilitate a person having ordinary skill in the art to make and use the invention as claimed. There are no limitations on how the sufficient detail is to be conveyed.

### **35 USC § 112 paragraph 2 – “Consisting Essentially Of”**

Applicant respectfully traverses Examiner’s rejection of the transitional phrase *“consisting essentially of,”* provided in Claims 10 and 11. The transitional language *“comprising,”* is open-ended, while *“consisting essentially of,”* is considered restricted to the material items specified in the Markush group; as such, *“consisting essentially of,”* is a lesser included subgroup of *“comprising.”* See the MPEP at § 2111.03 reproduced in part below. The transitional phrase *“consisting essentially of”* generally limits the scope of a claim to the specified materials or steps,

*“and those that do not materially affect the basic and novel characteristic(s)” of the claimed invention In re Herz, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976.)”*

Alternately, the Examiner may be applying an improper *per se* rule to the term “*essentially*” which the CCPA has repeatedly rejected. Moreover, USPTO Office policy articulated in the MPEP at §2172.02,

*“is not to employ per se rules to make technical rejections. Examples of claim language which have been held to be indefinite set forth in MPEP § 2173.05(d) are fact specific and should not be applied as per se rules.”*

Claim 5, 10, 19 have been amended to remove the purportedly indefinite term “*aesthetic appeal*.” Claim 5 has further been amended to include the limitation of “visually selected is based on...,” which removes all doubt as to the metes and bounds of this Claim. Antecedent basis for this amendment to Claim 5 is found in the specification in originally filed **Claims 4, 8 and 18**.

Applicant’s amendment should not be construed as an admission or agreement with the Examiner’s rejection for the same reasons cited in the traversal of Claims 10 and 11, discussed supra. For the reasons set forth supra, Applicant respectfully requests reconsideration and withdrawal of all rejections under 35 USC § 112 paragraph 2.

#### **Reconsidered 35 USC §103 and §112 Rejections**

Applicant appreciates and thanks Examiner for reconsideration and withdrawal of the rejections noted in Examiner’s Final Office Action of 03/22/2007.

#### **35 USC §103(a)**

Claims 1, 8 and 20 have been amended to include the limitation of “consolidated within a shelf stable processing facility.” This limitation is not taught or otherwise suggested by the cited prior art to *Bettencourt, Verhaeghe, or Sanders et al.*, either alone or in combination; nor is there any factual basis provided why one skilled in the art would be motivated to combine the cited art references to arrive at the invention as claimed. As such, the methods as claimed cannot be said to be obvious since Examiner’s cited reference to *Cruess* dates back to 1948, a period spanning nearly 60 years, in which there is virtually nothing found in any of the cited references to date which teaches, suggests, motivates or provides any factual basis for one skilled in the art to combine the shelf stable and fresh cut produce processes as Claimed.

The recent US Supreme Court ruling in *KSR Int'l. Co., v. Teleflex, Inc.*, requires that there be an

*“apparent reason to combine the known elements in the fashion claimed by the patent [application] at issue. To facilitate review, this analysis should be made explicit.”*

In addition, the USPTO internal memorandum of May 3, 2007 from the Deputy Commissioner for Patent Operations, Margaret Focarino, requires;

*“Therefore, in formulating a rejection under 35 U.S.C. § 103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed.”*

To wit, Examiner's supposition that one skilled in the art would be motivated for cost and efficiency reasons simply does not comport with the clear absence of any indication in the span of nearly 60 years of cited prior art, that the fresh cut produce and shelf stable processing could be combined as claimed. Mere supposition is not enough; the inquiry needs to have some basis in fact not found in applicant's specification. As such, Applicant respectfully submits that the Examiner has not met either the “TSM” test or the broader “*factual inquiry*” test (per *Graham*) to support a *prima facie* case of obviousness. Additional limitations and distinctions from the cited art follow below.

### **35 USC §103(a) - *Verhaeghe***

The cited prior art to *Verhaeghe* teaches an automated tomato slicing machine for use in a fresh cut produce process which collects the ends of the sliced tomatoes but does not state for what or how the collected ends are used.

As noted by the Examiner, paragraph 0030 states

*“Cutting off the stem (top) portion is however not essential, but can be useful for the further treatment of the end slices being separately collected.”*

Applicant believes the vague reference to “*further treatment*” alluded to in paragraph 0030 of *Verhaeghe* relates to either slicing by hand to recover additional produce slices or collected and used in the production of animal feed rather than for consumer consumption. Tellingly, paragraph 0019 of *Verhaeghe* states;

*“As already explained above, left and right hand end slices (tops and bottoms) of vegetables and, more in particular of tomatoes, are not desired by the consumer as they possess less tasty components such as style pieces, stalk pieces, the sepal, calyx pieces, peduncle pieces, and root pieces. The invention solves these inconveniences by offering a device that enables the collection of the desired slices only, being the intermediate slices.”*

Accordingly, there is no suggestion or motivation to do anything with the ends other than separately collecting them. However, even assuming *arguendo*, that the tops and ends were transported to a shelf stable processing facility, there is nothing to suggest that the shelf stable processing is consolidated with that of a fresh produce processing in a shelf stable processing facility as provided in amended Claims 1, 8 and 20.

In addition, Examiner’s statement,

*“Note: Since Verhaeghe teaches of processing without special conditions (i.e. refrigeration, ect), one of ordinary skill in the art at the time the invention was made would expect the processing as taught by Verhaeghe to be shelf stable. Additionally, since Verhaeghe teaches of a fresh cut process for tomatoes that is a shelf stable process, Verhaeghe teaches of consolidating a shelf stable process with a fresh cut process in a common facility.”*

The Examiner’s assumption is erroneous and contradictory as the plain meaning of a shelf stable processing requires some form of heat, chemical or irradiation treatment to render the produce product generally aseptic.

A reasonable definition of “shelf stable” is available from Wikipedia ([www.wikipedia.org](http://www.wikipedia.org)) and defines shelf stable as follows;

*“In the food processing industry, shelf stable refers to a version of a product that typically requires refrigeration, that has been altered so it can be safely stored and sold in sealed container at room temperature while still having a useful shelf life.”*

Moreover, Applicant specifically defined shelf stable processing at specification p 4, lines 8 and 9 as “aseptic bagging and canning processing streams.” This definition clearly comports with the generally accepted meaning of shelf stable processing in the art.

The process described in Verhaeghe only discloses a fresh cut produce process, and provides no suggestion or motivation to consolidate a fresh cut produce process with a shelf stable process as is provided independent Claims 1, 8 and 14. In addition, Verhaeghe does not teach or otherwise suggest how the fresh produce (tomatoes) is provided. This fact is acknowledged by the Examiner;

*“However [Verhaeghe] is silent to the method for collecting the tomatoes..”*

Applicant further notes that *Verhaeghe* is likewise silent as to the method of visually selecting and diverting the tomatoes in a consolidated shelf stable processing facility as well.

These limitations of receiving fresh produce by mechanical harvesting and visually selecting fresh produce in a consolidated shelf stable and fresh cut produce processing facility are likewise incorporated into Applicant’s independent Claims 1, 8, and 14 and dependent Claim 20.

**35 USC §103(a) - *Bettencourt***

The cited prior art to *Bettencourt* teaches a mechanical tomato harvester which harvests tomatoes and specifically states:

*“Great savings for the public have resulted by the use of mechanical harvesting of tomatoes, the tomatoes used for canning at least.”* Column 1, Lines 7-9 (*Bettencourt*)

The Examiner notes also notes that

*“Bettencourt discloses that the tomatoes are mechanically harvested, visually sorted by ripeness, and then transported for distribution to a cannery or other processing facility.”*

**Canning is a shelf stable process.** As such, applicant notes that *Bettencourt* is completely silent regarding fresh cut produce processing.

The Examiner again incorrectly assumes that

*“one of ordinary skill in the art would have been motivated to look to the tomato harvesting art, such as Bettencourt, to determine a method for collecting the tomatoes as disclosed by Verhaeghe.”*

The mechanical harvesting as taught in *Bettencourt* would introduce a significant amount of physical damage to the majority of tomatoes harvested including bruises, nicks, cuts, gashes, splits, squashes, smashes and related physical damages. This is the primary reason Bettencourt provides tomatoes to a cannery and lists nothing else as stated supra.

Moreover, a damaged (e.g., squashed) tomato will not work in the apparatus described in *Verhaeghe* as it requires an intact (i.e., undamaged) tomato in order to generate “*uniform thickness[es] of the collected slices.*” Paragraph 0015 (*Verhaeghe*) However, the damaged tomato would be perfectly acceptable for introduction into a shelf stable process since the tomatoes will be reduced to pulp and pastes anyway.

Fresh produce intended for direct consumer and fresh cut produce markets are generally handpicked or are otherwise separately field sorted away from the shelf stable processing facilities. **Harvesting of fresh produce is one of the main reasons why vast numbers of migrant laborers are used throughout the United States;** i.e., mechanical harvesting techniques damage the harvested produce, thereby rendering a substantial portion unmarketable to consumers.

**35 USC §103(a) – *Sanders et al.***

The cited prior art to *Sanders et al.* teaches modified atmospheric packaging (MAP) suitable for sliced tomatoes (fresh cut produce) and therefore may be used with the sliced tomatoes generated by *Verhaeghe*. However, MAP is incompatible with shelf stable processed produce since this process utilizes heat treatments (or irradiation) to largely sterilize (i.e., aseptic) the produce which is then disposed in long lived containers such as sealed cans, jars, bags and tubes. MAP does not use an aseptic process. The fresh produce and any bacteria existing at the time of packaging remain alive and are only growth inhibited by the expired carbon dioxide emitted from the produce. In short, using MAP with processed produce would completely defeat the entire shelf stable treatment process by allowing anaerobic bacteria to multiply.

**35 USC §103(a) – *Verhaeghe, Bettencourt and Sanders et al.***

The Examiner suggests that the three-way combination of *Verhaeghe*, *Bettencourt* and *Sanders et al.* renders the invention as claimed obvious. Applicant respectfully traverses this rejection as to at least independent Claims 1, 8 and 14.



As discussed supra, *Verhaeghe* does not teach or otherwise suggest that a portion of the fresh produce (tomatoes) is visually diverted from a shelf stable process to a fresh cut produce process within a consolidated shelf stable processing facility; nor is there any factual basis to conclude that one skilled in the art would reasonably consider combining the references to arrive at applicant's claimed invention.

In addition, *Verhaeghe* does not teach or otherwise suggest that the collected end slices are reintroduced into a shelf stable process. *Bettencourt* does not teach or otherwise suggest that the machine harvested tomatoes would be collected for anything other than a shelf stable process. This combination of shelf stable and fresh cut produce processing is only found in Applicant's patent application. As such, the combination must therefore be novel and non-obvious.

As discussed supra, fresh produce intended for fresh cut produce processing is manually harvested rather than machine harvested due to the damage inflicted on the produce by the mechanical harvester. Moreover, Applicant is not claiming how the fresh produce is cut

Accordingly, one skilled in the art would not be motivated to use the machine harvested tomatoes of *Bettencourt* for slicing as described in *Verhaeghe*. As also discussed supra, since MAP is incompatible with shelf stable processing, one skilled in the art would not be motivated to use MAP as provided in *Sanders, et al.*, in combination with the tomatoes harvested by *Bettencourt*. As such, the combination must therefore be novel and non-obvious. Accordingly, Applicant respectfully submits that the combination of *Verhaeghe*, *Bettencourt* and *Sanders et al.* does not teach or otherwise suggest the limitations included in the amended Claims. In particular, the following Independent Claim limitations clearly distinguish the cited prior art from Applicant's Claimed invention;

*"fresh cut produce process being separate from said shelf stable process but consolidated within a shelf stable processing facility," (Claim 1);*

*"diverting a visually selected portion," (Claims 1, 8, 14);*

*“consolidating a fresh cut produce process with said shelf stable process in a shelf stable processing facility,” (Claim 8);*

*“reintroducing at least some of the removed undesirable sections into the shelf stable process,” (Claim 8);*

*“consolidating a fresh cut produce process with a shelf stable process,” (Claim 14).*

Since all three independent Claims include at least **two** elements not taught or otherwise suggested by the cited prior art, Applicant respectfully submits that independent Claims 1, 8 and 14 are novel and non-obvious.

Claims 2, 3, 5-7 depend from Independent Claim 1 which as discussed above is believed novel and non-obvious. Accordingly, Claims 2, 3, 5-7 are likewise novel and non-obvious for at least the reasons discussed for Claim 1.

Claims 9-13 depend from Independent Claim 8 which as discussed above is believed novel and non-obvious. Accordingly, Claims 9-13 are likewise novel and non-obvious for at least the reasons discussed for Claim 8.

Claims 15-20 depend from Independent Claim 14 which as discussed above is believed novel and non-obvious. Accordingly, Claims 15-20 are likewise novel and non-obvious for at least the reasons discussed for Claim 14.

Therefore, for the reasons set forth supra, Applicant respectfully requests reconsideration and withdrawal of all rejections under 35 USC §103(a).

#### **Final Office Action**

Pursuant to MPEP §706.07(d) Applicant’s representative respectfully requests that the Final Office Action of March 22, 2007 be **withdrawn**. Examiner has cited new prior art having no material relationship to the amendments made to the Claims in response to Examiner’s first office action. As such, Applicant’s representative respectfully requests that the Final Office Action be withdrawn and entry of the Claims as amended in this response be made of record. Alternatively, the finality should be withdrawn and a timely notice of allowance be provided in this case.

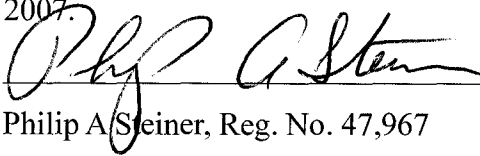
In the event the Examiner wishes to discuss any aspect of this response, please contact the attorney at the telephone number identified below.

Respectfully Submitted,

A handwritten signature in cursive script, reading "Philip A. Steiner".

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I hereby certify that this correspondence is being transmitted to the United States Patent and Trademark Office by electronic means on this date of May 10, 2007.

A handwritten signature in cursive script, reading "Philip A. Steiner", positioned above a horizontal line.

Philip A Steiner, Reg. No. 47,967